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REMARKS**Summary of the Claims**

Claims 1, 2, 4-11, 13-21, and 23-27 are pending in the present application. Claims 3, 5, 6, 8, 11, 12, 14-16, 18, 22, 24, and 25 were objected to by the Examiner, but found to be otherwise allowable. In this Response, Claims 1, 2, 10, 11, 20, and 21 have been amended, and Claims 3, 12, and 22 have been cancelled. Reconsideration of the rejected claims is respectfully requested.

Examiner Interview

Applicants note with appreciation the interview conducted between Applicants' undersigned attorney and the Examiner on May 4, 2004. During the interview, the Examiner and Applicants' attorney discussed amendment to claim 1 substantially as set forth in the amended claims included herewith. Applicants' attorney noted that the amendment should place the claims in condition for allowance as the amended independent claims include limitations not found by the Examiner during three previous searches (i.e., the subject matter of original claim 3). The Examiner agreed that the claims will be allowed so long as a subsequent search does not reveal art that teaches Applicants' amended independent claims. Should a subsequent search reveal such new art that was not uncovered during the previous three searches conducted by the Examiner, then the Examiner agreed that another non-final office action would be warranted to allow Applicants the opportunity to review, and possibly traverse, such new art in a non-final setting.

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35 U.S.C. § 102, Anticipation

Claims 1, 4, 7, 9, 13, 17, 19, 20, 23, 26, and 27 were rejected under 35 U.S.C. § 102 as being anticipated by US 5,463,625 (YASREBI) OCT 31, 1995. The rejections are respectfully traversed.

Specifically, the Examiner stated:

As to claim 1, Yasrebi teaches method comprising: receiving a close request (prior to put to sleep); and setting the adapter to a quasi-open state (put to sleep mode) in response to receiving the close request (col. 10, lines 52-64).

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). YASREBI fails to anticipate the presently claimed invention because it fails to show all of the elements of the claimed invention.

The rejected claims, whether independently or through dependency, all recite a feature of setting an adapter to a quasi-open state in response to receiving a close request. This feature is not taught by YASREBI.

The cited portion of YASREBI, relied upon by the Examiner in support of the rejection, describes using threads in a software process in order to simulate devices in a network:

The procedure call for each PortOpen command 67 issued by the client to the gateway server actually called a previously generated procedure stub. The call returned a handle from the server. The client then issued a Connect(out) 68 to the gateway that returned when a simulated successful outgoing call was established. The procedure call thread was then "put to sleep" for

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a random period of time 69 (to simulate random connection time between the LAN workstation application and a remote server), after which Disconnect and PortClose commands 70 and 71 were sequentially issued with the same handle before the thread was terminated 72. [col. 10, lines 52-64].

The Examiner has interpreted putting a thread to sleep as encompassing placing an adapter in a quasi-open state. Applicants respectfully disagree with this interpretation. Notwithstanding the fact that YASREBI teaches a software simulation of network devices, which is, on its face, distinct from the present claims' recitation placing an actual adapter in a quasi-open state, there are a number of clear differences between what is taught in YASREBI and what is recited in Applicants' claims such that even given the Examiner's broad reading of the rejected independent claims, YASREBI still fails to teach all of the elements of the presently rejected claims.

Firstly, the Examiner has failed to show that putting a thread to sleep is equivalent to placing an adapter in a quasi-open state. Even if one could make the argument that a thread that is intended to simulate a network device could be considered an "adapter," the Examiner has still failed to demonstrate that YASREBI's teaching of putting the thread to sleep even simulates a quasi-open state. A "quasi-open" state, as the name implies, is a state that resembles an open state in some respects, but is not actually an open state. The specification describes this as follows:

When a close request is received by the adapter, the adapter enters a quasi-open state rather than actually closing the adapter. The quasi-open state keeps the link between the adapter and the Fibre Channel network open by maintaining a minimal set of resources. Extended resources, needed to operate in open mode, are released. [p. 14, lines 6-11].

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Thus, a "quasi-open" state is a third kind of state, distinct from both an open state and a closed state. YASREBI fails to describe any such kind of third state. The above excerpt from YASREBI states that a thread is placed to sleep for a period of time to simulate random-length periods of connection between a workstation application and a server. YASREBI does not state or even imply that such a period is a "quasi-open" as opposed to an "open" state of connection; it simply states that that time period simulates a period of connection, without regard to what kind of connection is being simulated.

However, even if one skilled in the art could reasonably conclude that a sleeping thread simulating a connected network device could be considered an adapter in a quasi-open state, there is an even more compelling reason why YASREBI fails to teach all of the elements of the presently claimed invention, as argued by the Examiner. The cited excerpt relied upon by the Examiner as teaching Applicants' claimed feature of setting an adapter to a quasi-open state in response to receiving a close request actually describes something that is entirely incompatible with that teaching.

The Examiner asserts that putting a thread to sleep, as described in YASREBI, constitutes setting an adapter to a quasi-open state. The presently rejected claims, however, recite setting an adapter to a quasi-open state *in response to receiving a close request*. Thus, even if one could interpret a "quasi-open" state of an adapter as encompassing a sleeping thread, YASREBI would still fail to anticipate the presently claimed invention, because YASREBI fails to teach putting the thread to sleep *in response to receiving a close request*.

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Indeed, YASREBI not only fails to teach this claimed limitation, but YASREBI actually describes the complete opposite.

According to the above excerpt from YASREBI, upon which the entirety of Examiner's rejection is based, the close request (or PortClose command, as it is referred to in YASREBI) occurs only after the thread has been put to sleep. Thus, one skilled in the art would not—in fact, *could not*—reasonably interpret the act of putting a thread to sleep in above YASREBI excerpt as encompassing the claimed feature of setting an adapter to a quasi-open state in response to receiving a close request, the act of putting a thread to sleep in YASREBI is clearly *not* performed in response to receiving a close request. Hence, YASREBI not only fails to anticipate the presently claimed invention; if one assumes that putting a thread to sleep in YASREBI constitutes setting an adapter in a quasi-open state, then one must conclude that YASREBI actually teaches away from the presently claimed invention, as it is impossible to put a thread to sleep in response to a close request before the close request even occurs.

Notwithstanding Applicants' assertion that YASREBI fails to anticipate Applicants' independent claims, Applicants have amended independent claim 1 to include limitations found in original claims 2 and 3. Claim 3 was found to be allowable by the Examiner over the prior art. Specifically, this limitation requires that the light source on the Fiber Channel adapter not be toggled when switching between "quasi-open" and an "open" modes. Likewise, independent claims 10 and 20 have also been amended to include these limitations.

Therefore, Applicants respectfully submit that YASREBI fails to anticipate claims 1, 4, 7, 9, 13, 17, 19, 20, 23, 26,

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and 27, as the claimed feature of setting an adapter in a quasi-open state in response to receiving a close request, which is incorporated into all of these claims, is neither taught nor suggested by the YASREBI reference. Accordingly, Applicants respectfully request that claims 1, 4, 7, 9, 13, 17, 19, 20, 23, 26, and 27 be allowed.

35 U.S.C. § 103, Obviousness

The Examiner rejected claims 2 and 21 under 35 U.S.C. § 103 as being unpatentable over YASREBI in view of US 6,396,828 (LIU) MAY 28, 2002 further in view of US 5574774 (AHLBERG ET AL.) NOV 12, 1996 and also rejected claim 10 under 35 U.S.C. § 103 as being unpatentable over YASREBI in view of LIU in further view of US 6,038,235 (HO ET AL.) MAR 14, 2000. These rejections are respectfully traversed.

Claims 2 and 21 are dependent claims that depend on independent claims 1 and 20. Applicants have already demonstrated claims 1 and 20 to be in condition for allowance. Applicants respectfully submit that claims 2 and 21 are allowable for the same reasons provided in support of claims 1 and 20 above, at least by virtue of their dependency on those allowable claims. Moreover, the AHLBERG reference fails to cure the deficiencies of YASREBI with respect to the rejections of claims 1 and 20. AHLBERG does not recognize a third adapter state (i.e., a "quasi-open" state) that is distinct from an open state and a closed state. Hence, AHLBERG, whether considered individually or in combination with the cited YASREBI reference, also fails to teach or suggest the features of claims 2 and 21. In addition, as discussed at length above, this Office Action is the first action in which a citation to the AHLBERG reference

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appears. Therefore, it is improper, under MPEP 706.07(a), for this Office Action to be made Final with respect to Claims 2 and 21. Accordingly, Applicants respectfully request the withdrawal of the finality of this Office Action. Finally, independent claims 1 and 20, upon which claims 2 and 21 respectfully depend, have been amended to include limitations originally found in dependent Claims 2 and 3 (for Claim 1) and 21 and 22 (for Claim 20). Therefore, as explained in the preceding section, Claims 1 and 20 are allowable over the art of record. Consequently, because Claims 2 and 21 depend upon allowable subject matter, Claims 2 and 21 are allowable for at least this reason.

Claim 10 is an independent claim, but as it recites the same feature of setting an adapter in a quasi-open state in response to receiving a close request, it is also patentable over the prior art of record for the same reasons set forth with respect to the other independent claims, claims 1 and 20. Moreover, the HO reference fails to cure the deficiencies of YASREBI with respect to the rejections of claims 1, 10, and 20. While HO "relates generally to methods and apparatus for data communication on a fiber channel loop" (col. 1, lines 32-46), HO fails to teach or suggest the critical feature of setting an adapter in a quasi-open state in response to receiving a close request. Finally, independent claim 10 upon which claim 11 depends, has been amended to include limitations originally found in dependent Claims 11 and 12. Therefore, as explained in the preceding section, Claim 10 is allowable over the art of record. Consequently, because Claim 11 depends upon allowable Claim 10, Claims 11 is allowable for at least this reason.

For the foregoing reasons, Applicants respectfully submit that claims 2, 10, and 21 are patentable over the prior art of

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record and respectfully request that claims 2, 10, and 21 be allowed.

Conclusion

As a result of the foregoing, it is asserted by Applicants that all pending claims in the Application are in condition for allowance, and Applicants respectfully request allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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